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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/578,497	04/02/2007	Reiner Fischer	2400.030000/VLC/CMB	1712
26111 7590 09/23/2009 STERNE, KESSLER, GOLDSTEIN & FOX P.L.L.C. 1100 NEW YORK AVENUE, N.W. WASHINGTON, DC 20005				
EXAMINER CHU, YONG LIANG				
ART UNIT		PAPER NUMBER		
1626				
MAIL DATE		DELIVERY MODE		
09/23/2009		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/578,497

Applicant(s)

FISCHER ET AL.

Examiner

YONG CHU

Art Unit

1626

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 01 June 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 3-6, 8, 9, 11-15 and 17-19 is/are pending in the application.
- 4a) Of the above claim(s) 6, 9, 11-15, and 17-19 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 3-5 and 8 is/are rejected.
- 7) ☒ Claim(s) 3-5 and 8 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Claims 3-6, 8-9, 11-15 and 17-19 are pending. Claims 6, 9, 11-15 and 17-19 remain withdrawn as non-elected subject matter. Therefore, claims 3-5 and 8 are under examination on the merits.

Response to Amendment

The Amendment by Applicants' representative Ms. Cynthia M. Bouchez dated on 06/01/2009 has been entered.

Response to Arguments

Objection to the Specification

Applicants' argument regarding substituents D and A as a part of a ring has been fully considered, and is found persuasive. Therefore, the objection is withdrawn.

Claim rejection under 35 U.S.C. §112 2nd paragraph

Applicants' argument regarding substituents D and A as a part of a ring has been fully considered, and is found persuasive. Therefore, the rejection is withdrawn.

Claim Objection

The claim objection is maintained because the claims still contain non-elected subject matter. The instantly elected scope of invention was described in the previous Office action.

Claim rejection under 35 U.S.C. §103(a)

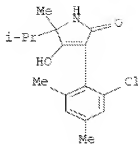
Applicants argument on the ground that the Office has failed to provide a rational as to why a person of ordinary skilled in the art would replace methyl with any other

alkyl at the **Z** position has been full considered, but is found not persuasive. The previously cited '196 patent teaches pesticides and/or herbicides sharing the same core structure of the instantly claimed compounds. The only difference between the '196 compound and the instantly claimed compounds is at **Z** as a methyl group vs. an ethyl group, and they are homolog. The motivation for modifying the prior art teaching to the instant application was articulated at page 7 of the Office action.

In addition, the 132 Declaration filed on 06/01/2009 by Dr. Heinz Kehne is also not sufficient to overcome the rejection for the following reasons: 1) the Declaration did not declare who created the testing data and how the data related to the instant application; 2) the Declaration was not filed by Dr. Heinz Kehne, because it used "he", not "I"; the compounds tested in the Declaration are the compounds wherein **X** is -Br, not -Cl as cited in the '196 compound, and no unexpected results has been demonstrated over the cited prior art compound. Therefore, the rejection is maintained.

Obvious-type Double Patenting Rejection

Applicants' argument on the ground that the claims of the '274 patent disclose thousand of compounds, and the Office has not provided a reason why a person of ordinary skilled in the art would choose a compound wherein **X** is chlorine or bromine, **Y** is methyl or ethyl and **Z** is ethyl or n-propyl as a lead compound from among the thousands of compounds recited by the '274 patent has been fully considered, but not persuasive. The claimed scope between the instant claims 3-5 and 8 and claims 1-4, 6 and 8 of the '274 patent are overlapped with the same core structure, and the



compound (CAS RN 186746-85-0) disclosed in the '274 patent is a homolog, which reads on the instant claims, wherein **Z** is -CH₃, and renders the instant claims obvious (i.e. **Z** is -CH₃ vs. -Et). See Page 8 of the previous Office action, and the analysis under 103(a) above. Therefore, the ODP rejection is maintained.

Conclusion

- No claims are allowed.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Telephone Inquiry

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Yong Chu whose telephone number is 571-272-5759. The examiner can normally be reached on 7:00 am - 3:30 pm EST. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph M^{re}Kane can be reached on 571-272-0699. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Status information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only.

/Yong Chu/
Patent Examiner
Art Unit 1626

/Kamal Saeed/
Primary Patent Examiner
Art Unit 1626

Application/Control Number: 10/578,497
Art Unit: 1626

Page 6